

REMARKS

This paper is in response to the final official action of July 10, 2008, wherein (a) claims 1 – 26 and 36 – 47 were pending, (b) claims 27 – 35 stand canceled as directed to non-elected inventions, and (c) claims 1 – 26 and 36 – 47, 16 stand rejected under 35 U.S.C. § 102 as anticipated by Fischell (U.S. Patent No. 6,086,604) or under 35 U.S.C. § 103 as obvious in light of Fischell either alone or in combination with Pacetti (U.S. Publication No. 2002/0188345), Da Silva (U.S. Patent No. 6,729,336), and/or Smith (U.S. Publication No. 2002/0156525).

Applicant has amended claim 1 above to correct the antecedent basis of the term “3-D structure.” The amendment is of a corrective nature and thus in condition for entry after final.

The applicant appreciates the examiner’s removal of the previous prior art rejections.

The applicant has carefully considered the current rejections based on Fischell and respectfully, but strongly, traverses. Fischell clearly does not teach a planar structure expandable into a 3-D structure in the first instance, nor a planar structure having the recited elements in the second instance. For these reasons alone, as well as for the deficiencies that would still persist when purportedly combining Fischell with the other art of record, the rejections are traversed.

Claim 1 recites a planar structure expandable into a 3-D structure. The office action fails to show where it believes that Fischell shows a planar structure. In fact, Fischell does not. Instead, Fischell shows and describes (see, e.g., the cross-sectional view in Figure 2 and the lengthwise view in Figure 1) a **tubular-shaped** stent formed of a series of rings (2) held together by longitudinal beams (4T, 4B, 4R, and 4L) which are described as welded, adhesively bonded or joined with recesses in each ring. This tubular stent is the initial state of the Fischell stent; **that is, Fischell no where describes a planar structure or a stent having a planar structure.** In Figure 5, the rings are ellipses or ovals (2’) having major and minor axes, but the structure is still tubular, extending in three dimensions at all times. Figures 6 and 7 merely show that the tubular stent has a radius that can be reduced by pulling

on the longitudinal beams (4L and 4R) while keeping the other longitudinal beams (4T and 4B) fixed. This skews the oval shaped rings to allow for better implantation. Yet, as Fischell makes clear, the stent is still a three dimensional structure, at all times and thus never planar. See, e.g., Fischell, Col. 2, ll. 27-30 (stating “ovals have been folded into a small diameter *cylinder*.”). The same holds for the embodiment of Figure 8, and the unitary configuration of Figure 9. Furthermore, not only does Fischell fail to teach a planar structure, one of ordinary skill would not be motivated to modify Fischell into a planar structure, because Fischell’s rings appear physically incapable of forming a planar structure. Whether it be the left and right portions or the top and bottom portions, the curved-nature of the rings would always be self-limiting in this regard.

In contrast to the tubular stent structure of Fischell, claim 1 is directed to a **planar** structure expandable into a 3-D structure. The application provides numerous examples of such structures; and therefore the examiner’s attention is directed to the application as a whole. Comparing the recited subject matter against the office action, it is clear that nowhere does the office action show where Fischell teaches a planar structure expandable into a 3-D structure and having the recited claim elements. And to this point, it is noted that structural language in the preamble is not treated the same as language reciting purpose or intended use, but rather is often considered vis-à-vis the prior art. See, MPEP 2111.02; see also, *Computer Docking Station Corp. v. Dell Inc.*, (Fed. Cir. March 21, 2008) (distinguishing preambles that simply introduce a general field of the claim); *Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997) (discussing how the PTO is to treat preambles with structural recitations). With respect to claim 1, it is clear that Fischell cannot be said to teach a planar structure expandable into a 3-D structure and having the recited claim elements. In fact,

The rejection of claim 1 based on Fischell is traversed as improper. Furthermore, no combination of Fischell and any other art of record can be said to teach the recited subject matter. Likewise, the rejections of claims 2 – 26 depending from claim 1 are traversed.

Independent claim 36 recites a stent having a planar structure in a non-expanded position and expandable into a 3-D structure in an expanded position. For at least the reasons outlined above, it is clear that the rejection of claim 36 based on Fischell is

improper. For example, Fischell does not describe a stent having a planar structure in a non-expanded position. Further still, claim 36 generally recites a first set of cross-bands that are expandable in first direction and that include “a plurality of interconnected and folded back first and second beam sections disposed in a plane of the stent when the stent is in the non-expanded position,” and a second set of cross-bands that are expandable in an opposition direction and that include “a plurality of interconnected and folded back first and second beam sections disposed in the plane of the stent when the stent is in the non-expanded position.” None of the rings 2, 2', 2'', 2''' in Fischell are disposed in a plane of a stent, but rather these rings are always formed collectively into a three dimensional, tubular stent held together by the longitudinal beams. The rings may extend radially from a longitudinal axis of the stent, but in none of the orientations are the rings held in a plane.

Thus, the rejections of claim 36 and claims 47 – 45 depending therefrom are traversed.

Independent claim 46, recites a stent having “a unitary stent structure disposed in a plane when in a non-expanded position and having a longitudinal axis.” For at least the reasons outlined above, the rejection of claim 46 based on Fischell is improper. The rejections of claim 46 and claim 47 depending therefrom are traversed.

In view of the above amendment, applicant believes the pending application (claims 1-26 and 36-47) is in condition for immediate allowance.

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Respectfully submitted,

By 

Paul B. Stephens

Registration No.: 47,970

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant